

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Amendment filed 1/15/04. Claims 1, 114 and 116 have been amended. Claims 1-174 are pending.

Claim Rejections - 35 USC §101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

3. Claims 1-13, 17-30, 32, 37-72, 75, 77, 116-130, 138-150, 153 and 155-174 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

In the present case, claims 1-13, 17-30, 32, 37-72, 75, 77, 116-130, 138-150, 153 and 155-174 recite "a computer system for providing a plurality of participants" in its preamble but does not recite any technological device in the body of the claim in performing the various steps of "processing" within the computer system.

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory

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subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble.

As per claim 1, Examiner respectfully requests a clear and definite language tying the body of the claim to a technological device such as a computer, and not merely in the preamble.

As per claim 116, Examiner respectfully submits that the recited "computer-readable medium" is utilized in a trivial manner (i.e., passively recorded). In order to pass muster under 35 U.S.C. 101, the recited technological device must be employed in a non-trivial manner (e.g.), "for producing at least one end-of-life information packet".

As to technological arts recited in the preamble, mere recitation in the preamble (i.e., intended or field of use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea unless there is positive recitation in the claim as a whole to breathe life and meaning into the preamble. In the present case, none of the recited steps are directed to anything in the technological arts as explained above with the exception of the recitation in the preamble that the method is "a computer system". Looking at the claim as a whole, nothing the body of the claim recites any structure or functionality to suggest that a computer performs the recited steps. Therefore, the preamble is taken to merely recite a field of use.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed

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invention produces end-of-life information (i.e., repeatable) used in helping participants to make choices for a service (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-174 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arbuckle (5,651,117) in view of Slotznick (5,983,200), for substantially the same reasons given in the previous Office Action (Paper number 7) and further in view of Krim (2002/0072925). Further reasons appear hereinbelow.

(A) As per the added features to claim 1, the combination of Arbuckle and Slotznick do not explicitly disclose "said information relating to the care of said plurality of participants and determined by said plurality of participants".

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However, this feature is known in the art, as evidenced by Krim. In particular, Krim suggests "said information relating to the care of said plurality of participants and determined by said plurality of participants" (See Krim, Page 5, Paragraphs 0063-0066).

One of ordinary skill in the art at the time of the invention would have found it an obvious modification to include the feature of Krim within the combined teachings of Arbuckle and Slotznick with the motivation of providing individual recipients such that further editing of the communication designated for delivery to the group is effective as to all individual recipients of the group (See Krim, Page 1, Paragraph 0005).

The remainder of claim 1 is rejected for the same reasons given above in the previous Office Action (Paper number 7), and incorporated herein.

(B) As per the added features to claim 114, the combination of Arbuckle and Slotznick do not explicitly disclose "on a computer readable medium, said information set relating to the care of the participant and determined by the participant".

However, this feature is known in the art, as evidenced by Krim. In particular, Krim suggests "on a computer readable medium, said information set relating to the care of the participant and determined by the participant" (See Krim, Page 5, Paragraphs 0063-0066).

One of ordinary skill in the art at the time of the invention would have found it an obvious modification to include the feature of Krim within the combined teachings of Arbuckle and Slotznick with the motivation of providing individual recipients such that

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further editing of the communication designated for delivery to the group is effective as to all individual recipients of the group (See Krim, Page 1, Paragraph 0005).

The remainder of claim 114 is rejected for the same reasons given above in the previous Office Action (Paper number 7), and incorporated herein.

(C) As per the added features to claim 116, the combination of Arbuckle and Slotznick do not explicitly disclose "said end-of-life information relating to the care of said plurality of participants and determined by said plurality of participants and recorded on a computer readable medium". However, this feature is known in the art, as evidenced by Krim. In particular, Krim suggests "said end-of-life information relating to the care of said plurality of participants and determined by said plurality of participants and recorded on a computer readable medium" (See Krim, Page 5, Paragraphs 0063-0066).

One of ordinary skill in the art at the time of the invention would have found it an obvious modification to include the feature of Krim within the combined teachings of Arbuckle and Slotznick with the motivation of providing individual recipients such that further editing of the communication designated for delivery to the group is effective as to all individual recipients of the group (See Krim, Page 1, Paragraph 0005).

The remainder of claim 116 is rejected for the same reasons given above in the previous Office Action (Paper number 7), and incorporated herein.

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(D) Claims 2-113, 115 and 117-174 have not been amended and are rejected for the same reasons given in the previous Office Action (Paper number 7), and incorporated herein.

Response to Arguments

6. Applicant's arguments filed 01/15/04 regarding claims 1, 114 and 116 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 01/15/04.

At pages 34-35 of the response 01/15/04 response, Applicant's argues the followings:

(1) Arbuckle reference does not teach the problem addressed by the Applicant.

(2) Slotznick should not render the invention as a whole obvious as the problem itself and the solution to the problem was not suggested by the prior art.

(3) Arbuckle does not describe a system to make decisions that relate to the case of the patient at cited section Col.1, lines 9-67.

(4) Arbuckle teaches an organ donation form, which is not a portion of a laboratory report.

(A) In response to Applicant's argument that the Arbuckle reference does not teach the problem addressed by the Applicant, the Examiner respectfully submits that the recited claims do not reasonably convey the concept that Applicant presently disputes. In particular, exemplary claim 1, lines 7-8 requires "... said information set comprises end-of-life information...". Applicant presently argues that the term "end-of-life" refers the end (or final) stages of life, but does not point to any portion of the instant

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specification that provides such an explicit definition of this term. MPEP Section 2111.01 provides the following guidance:

While the claims of issued patents are interpreted in light of the specification, prosecution history, prior art and other claims, this is not the mode of claim interpretation to be applied during examination. During examination, the claims must be interpreted as broadly as their terms reasonably allow. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) (discussed below)>; *MSM Investments Co. v. Carolwood Corp.*, 259 F.3d 1335, 1339-40, 59 USPQ2d 1856, 1859-60 (Fed. Cir. 2001)” and further that: Applicant may be his or her own lexicographer; however any special meaning assigned to a term “must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention.” *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). >See also *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999)

In light of the above, the Examiner respectfully submits that the plain meaning of the term “end-of-life” is death, as death is, literally, the end of one’s life. In this regard, the Examiner respectfully submits that the teachings of the Arbuckle reference are indeed relevant to the Applicant’s invention in the manner recited within the instant claims. Further, in response to Applicant’s argument that the references fail to show

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certain features of Applicant's invention, it is noted that the features upon which applicant relies (i.e., the final/last stages of one's life) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(B) With respect to Applicant's arguments against the Slotznick reference, the Examiner respectfully submits that Applicant fails to appreciate the vast breadth of the presently pending claims, as noted above. In addition, Slotznick was relied on solely for teaching of "the ability to effect choices about the care of said participants", a limitation which was recited only within the preamble of exemplary claim 1. The Examiner is unclear as to why Applicant believes this specific limitation is directly tied to the problem solved in the instant invention and its solution by Applicant. It is noted that it has been held that "the fact that Applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Moreover, when considering the fact that Slotznick is the secondary reference that is to be considered collectively in combination with the primary reference Arbuckle, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir.

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1986). Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(C) With regard to Applicant's contention that col. 1, lines 9-67 of Arbuckle fail to disclose "an authorization to rely on a copy of an original document" as recited in claim 4, the Examiner concedes that this the cited passage of Arbuckle fails to expressly disclose "an authorization to rely on a copy of an original document". However, it is noted that claim 4 is drafted as a Markush group, as such, is a form of alternative expression (please see MPEP 2173.05(h)). Therefore, the applied prior art need not show each and every item recited in the Markush group, but rather, needs to show only one of the items recited in the Markush group. In the instant case, element (j) of claim 4 recites "an advance directive". The Examiner respectfully submits that the information provided in obituaries described in col. 1, lines 9-67 of Arbuckle typically include directives regarding the time and place of a memorial service (before it has occurred), as well as advance information regarding the sending of donations to the deceased favorite charity (in lieu of flowers or contributions to the immediate family). Such items are respectfully submitted by the Examiner to be a form of "advance directive".

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(D) With respect to Applicant's last argument that Arbuckle discloses the utilization of an organ donation form, which not a portion of a laboratory report, the Examiner respectfully submits that Applicant fails to properly consider the cited passage (col. 2, lines 31-52) in its entirety. In particular, this passage refers to the Background of the Arbuckle Invention and specifically describes another prior art invention, the system of Perry, et al. (US Pat. No. 5,241,466). Arbuckle concludes that the system of Perry "does not monitor any source or sources of information for reports of death ... It presumes a knowledge of death or immanent death by one who submits an inquiry to the depository, typically from a hospital ... (Arbuckle; col. 2, lines 41-50). Arbuckle then contrasts that to his invention, which clearly monitors the sources of information for reports of death, such as government agencies, licensed funeral directors, and other special or private sources (Arbuckle, col. 6, line 16 to col. col. 9, line 32). It is respectfully submitted that government agencies and/or funeral directors typically require a report from a coroner or the like as official verification of a death. Further, certain government agencies such as the police department include labs reports in a coroner's report, especially if the death is believed to be a homicide. As such, it is respectfully submitted that one having ordinary skill in the art at the time of the invention would have understood the cited passages of Arbuckle, when considered properly with the knowledge available to one generally skilled in the art, would clearly have disclosed the disputed feature of "at least a portion of a laboratory report". In this regard, the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in

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combination with that knowledge, would put the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

In addition, insofar as Applicant uses alternative expressions (e.g., the Markush format), it is irrelevant as to whether the applied prior art discloses all of the items a, b, and c recited in exemplary claim 5.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches posthumous communication (2002/0072925), system and method of planning a funeral (2002/0004757).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on Monday-Thursday from 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

V.F
V.F
April 5, 2004


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
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09/616,472	07/14/2000	Whitney Durand	AD-1	6507

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EXAMINER

FRENEL, VANEL

ART UNIT PAPER NUMBER

3626

DATE MAILED: 04/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/616,472

Applicant(s)

DURAND, WHITNEY

Examiner

Vanel Frenel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-174 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-174 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.